

REMARKS

Claims 1-12 and 15-36 are pending in this application. Claims 13 and 14 were previously canceled without prejudice or disclaimer to the subject matter therein. Claims 1-12 and 15-36 have been amended.

The canceled claims were canceled without prejudice or disclaimer, and claims 1-12 and 15-36 have been amended, for the sole reason of advancing prosecution. Applicant, by canceling or amending any claims herein, makes no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicant reserves the right to reassert any of the claims canceled herein or the original claim scope of any claim amended herein, in a continuing application.

Claims 2-12 and 15-33, and claims 35 and 36 depend, either directly or indirectly, from claims 1 and 34, respectively. Claims 1-12 and 15-36 have been amended to be in a form consistent with U.S. practice. For example, the term "said" has been deleted and replaced with the term "the." Additionally, antecedent basis has been corrected.

Support for the specification and claims as amended, appears throughout the specification and claims as originally filed. It is respectfully submitted that the amendments do not introduce any new matter within the meaning of 35 U.S.C. §132.

In view of the remarks set forth below, further and favorable consideration is respectfully requested.

I. At page 2 of the Official Action, claim 32 has been objected to under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The Examiner asserts that “[T]hese claims [sic] recite intended use that fails to further limit the structure of the claimed invention. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.”

By this Response and Amendment, Applicant provides amended claim 32 rewritten to remove the Examiner asserted intended use language. Claim 32 recites:

The handheld defense weapon according to claim 1, configured sufficient to be used as a bag carrier wherein a bag is suspended from the handheld defense weapon by hanging handles of the bag on the first and second spikes.

Thus, Applicant respectfully submits that amended claim 32, as presented, further limits the subject matter of claim 1. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the objection thereto.

II. At pages 2-3 of the Official Action, claims “15, 26 and their dependant [sic] claims” have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention.

The Examiner has made the following rejections: (i) claim 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention, asserting that “[i]n claim 15, ‘fur-like’ is indefinite. Applicant submits that fur-like is not indefinite since it conveys real fur as well as synthetic fur. However, the problem with such a term is that the

scope of the claim cannot be determined. Most broadly a product such as Velcro, carpet or any cloth with a plush nap can arguably be described as ‘fur-like’. Since one cannot determine the metes and bounds, this term remains indefinite”; and (ii) claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention, asserting that “Claim 26 is indefinite without a relative standard to what is considered ‘soft’. For the purposes of this rejection, metals such as brass are considered ‘soft’. As to a relative term such as ‘soft material’ containing no measurable means for comparison, the claim is rendered indefinite. The term is subjective, while one may consider brass to be soft as a metal, it certainly would not be considered soft by one when struck. Here soft is a relative term that renders the claim indefinite.“ Applicant notes that the claims dependent from claim 15 and 26 were not otherwise explicitly addressed by the Examiner in the Official Action.

Applicant thanks the Examiner for his consideration of the Response filed September 2, 2008 and his indication of and withdrawal of the previous rejection to claim 31 in view of the amendments made in the September 2, 2008 Response.

In view of the following, these rejections are respectfully traversed.

With regard to (i), by this Response and Amendment, Applicant provides claim 15 in amended form without the Examiner rejected “fur-like” term. Claim 15 recites, *inter alia* “...wherein the weapon further comprises a covering material disguising the shape of the handheld defense weapon applied at least partially thereto.” Support for this amendment is

provided throughout the original specification and claims as filed, at least in the paragraph beginning on line 17 of page 10 of the original specification and by Fig. 4C.

With regard to (ii), by this Response and Amendment, Applicant provides claim 26 in amended form without the Examiner rejected “soft” term. Claim 26 recites, *inter alia*, “whereby the handheld defense weapon is made from a non-rigid material.” Support for this amendment is provided throughout the original specification and claims as filed, at least in the paragraph beginning on line 19 of page 6 of the original specification in which “rigid materials, e.g., plastic, metal, wood, etc.” are contrasted with “soft material[s] such as foam or rubber.” By this Response and Amendment, Applicant also submits specification amendments to clarify that the latter materials may be termed “*non-rigid* soft materials.” Applicant further respectfully submits that one of ordinary skill in the art would clearly understand the benefit derived from the weapon being made from rigid materials or alternatively, from the weapon being made of non-rigid soft materials to facilitate use during training and reduce injury to training participants (as further discussed in the specification paragraph referred to above) who would otherwise likely be at least bruised by a weapon made of a rigid material, such as brass, as seemingly understood by the Examiner, as indicated by his comments in the Official Action.

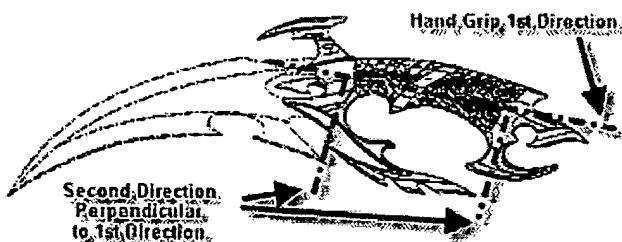
In view of the foregoing, it is submitted that claims 15 and 26 are clear and definite within the meaning of 35 USC § 112, second paragraph. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections thereto.

Similarly, Applicant respectfully submits that claim 30 is definite *inter alia*, at least due to its direct dependency from definite claim 26, for the reasons discussed in detail

above. Applicant respectfully requests reconsideration and withdrawal of the rejection(s) of claims "15, 26 and their dependant [sic] claims [30]."

III. At pages 3-4 of the Official Action, claims 1 and 3-12 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Rae (U.S. Design Patent No. D478,957).

The Examiner has rejected claims 1 and 3-12 under 35 U.S.C. § 102(a) as being anticipated by U.S. Design Patent No. D478,957 to Rae et al. (hereinafter referred to as "Rae et al.") "as set forth in the previous office action," although "Applicant remarks that Rae does not show first and third spikes generally perpendicular to the first direction is not agreed with based on the broadest interpretation. Here the claims call for "directions" that the spikes extend with respect to a direction of a grip portion. From the figure [the Examiner provided] below, one can see where the spikes extend in a direction perpendicular to the grip as called for by the claims."



"Where it appears that applicant is intending to amend the scope of the claims to recite the shape as described in his fig. 1B," [sic].

In view of the following, these rejections are respectfully traversed.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each

and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Amended claim 1 is directed to a handheld defense weapon, comprising:

a first hand grip portion extending along a first direction and comprising a first spike fitted at a first end of the first hand grip portion, and a second spike provided at a second end of the first hand grip portion, the first and second spikes facing in the same direction; and

a third spike at the first end of the first hand grip portion, extending in an opposite direction from the first spike, wherein the first and third spikes form **a second hand grip portion** extending **only** along a second direction generally **perpendicular** to the first direction" (emphases added).

Claims 3-12 depend, either directly or indirectly, from amended claim 1.

Applicant respectfully disagrees with the Examiner's assertions and submits that in contrast to the presently pending subject matter, Rae et al. lacks, *inter alia*, the teaching of "first and third spikes... along a second direction generally **perpendicular** to the first direction" (emphasis added) as recited in the present claims.

Applicant respectfully refers to and (re)submits the following Examiner's annotations of Fig. 1 of Rae et al. from the Official Actions mailed December 29, 2008 and April 30,

2008 and points to the contradictions between these two figures to support that Rae et al. lacks, *inter alia*, this feature recited in the claims.

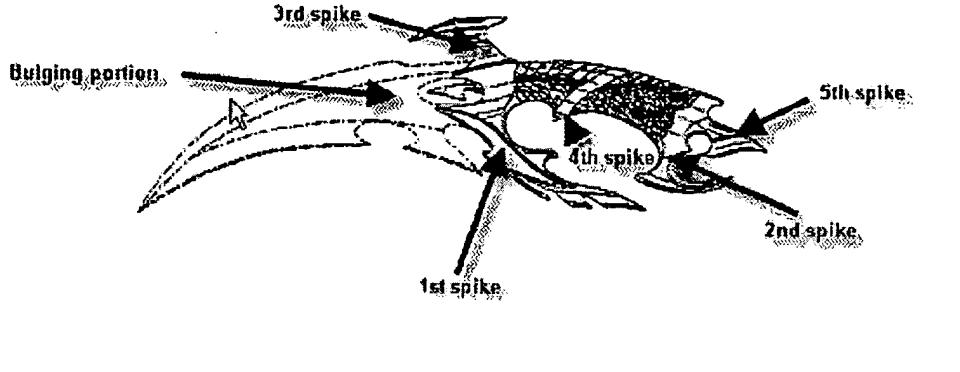


Fig. A: Examiner annotated Rae et al. Fig. 1 (April 30, 2008 Official Action)

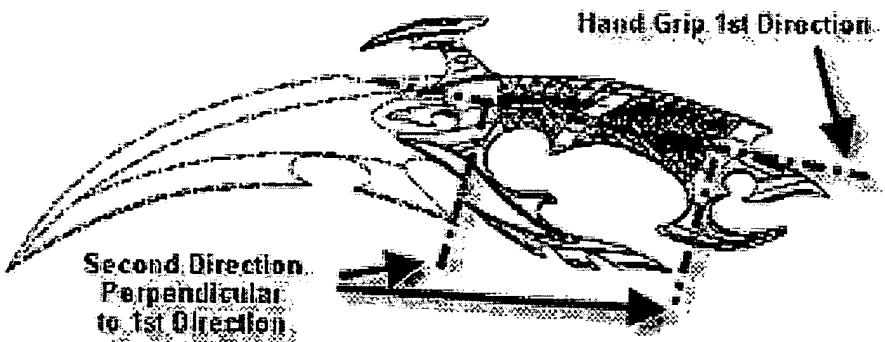


Fig. B: Examiner annotated Rae et al. Fig. 1 (December 29, 2008 Official Action)

In Fig. A, reproduced from the April 30, 2008 Official Action, the Examiner annotated Fig. 1 of Rae et al. to show an asserted "1st spike," "2nd spike," "3rd spike," "4th spike," and "5th spike," and a "Bulging portion." In Fig. B, reproduced from the December 29, 2008 Official Action, the Examiner annotated Fig. 1 of Rae et al. to show a "Hand Grip 1st Direction" and a "Second Direction Perpendicular to 1st Direction." Applicant notes that as annotated by the Examiner to correspond to the claimed subject matter, the "Second

Direction Perpendicular to 1st Direction" is not formed by the Examiner labeled "1st spike" and "3rd spike" as would be required by the claimed subject matter, but rather, is formed relative to the Examiner labeled "1st spike" and "2nd spike." Therefore, as asserted by the Examiner and shown through the provided annotated drawings (Fig. A and Fig. B), Rae et al. is incapable of disclosing or teaching "first and third spikes... along a second direction generally **perpendicular** to the first direction" (emphasis added) as recited in the present claims.

Applicant respectfully submits that Rae et al. lacks, *inter alia*, this feature recited in the claims and therefore does not teach "a third spike at the first end of the first hand grip portion, extending in an opposite direction from the first spike, wherein the first and third spikes form a **second hand grip portion**," as recited in the claims. If this rejection is to be maintained, the Examiner is respectfully requested to expressly address the foregoing.

Applicant incorporates by reference, the arguments made in the Response filed September 2, 2008 in their entirety.

Firstly, Rae et al. discloses an ornamental knife handle, which Applicant notes is formed with three extensions, each extension having several spikes. Thus, by referring to these extensions as being equivalent to the spikes recited and defined in the claims of the present application, as previously discussed, the ornamental knife handle fails to comply with the definition of 'spike,' implying a pointy element. Alternatively, by referring to the spikes of these extensions as being equivalent to the spikes recited in claim 1, the ornamental knife handle fails to comply with the constructional and geometric features recited in claim 1.

Further, Applicant notes that the ornamental knife handle of Rae et al. is designed and configured for accommodating and being used in conjunction with a blade attached thereto (shown in dashed lines in each figure of Rae et al., including in reproduced Figs. A and B discussed above). Thus, the first extension and third extension of Rae et al. **cannot** “form a second hand grip portion” as recited in the present claims. One of ordinary skill in the art would not be inclined to place or grip their hand upon such a portion of an ornamental knife handle when the only ‘hand grip portion’ is clearly in the middle of the knife handle, much less to place or grip their hand upon such a portion where a blade is attached thereto. Furthermore, being an ornamental knife handle as discussed above, one of ordinary skill in the art is highly unlikely to remove the blade portion therefrom and use the Rae et al. ornamental knife handle as a standalone handheld weapon. *Assuming arguendo*, one were to attempt using the Rae et al. ornamental knife handle as suggested by the Examiner, using the first and third extensions of the Rae et al. ornamental knife handle as a grip portion in the manner disclosed in the presently claimed subject matter and shown at least in Applicant’s Figs. 5A and 5B would prove **impossible** due to the pointy protrusions extending towards the blade portion. Applicant respectfully submits that not only would such a ‘grip’ prove very uncomfortable, there is simply **not enough** surface area, in that area of the Rae et al. ornamental knife handle for one to grip and hold onto the knife handle sufficiently, to use the Rae et al. ornamental knife handle as a weapon as described. Taking into consideration the “Bulging portion” also annotated by the Examiner in the area between the “1st spike” and “the 3rd spike” further precludes the use of the Rae et al. ornamental knife handle “wherein the first and third spikes form a second hand grip

portion" as recited in the present claims.

Applicant respectfully submits that Rae et al. lacks, *inter alia*, the above discussed features recited in the claims, and is therefore furthermore incapable of disclosing or teaching the second hand grip portion "extending **only** along a second direction generally **perpendicular** to the first direction" (emphases added) as recited in the present claims. As discussed above, the Examiner has indicated that, *inter alia*, a "Bulging portion" which protrudes from the Rae et al. ornamental knife handle in line with the "slightly curved" (see page 3 of the April 30, 2008 Official Action) asserted "first hand grip portion" is also in the area of the second hand grip portion, thereby precluding any asserted 'second hand grip portion' from "extending **only** along a second direction generally **perpendicular** to the first direction" (emphases added) as recited in the present claims." Further, this recitation of an extension perpendicular in the claims is contrary to the ornamental knife handle as disclosed in Rae et al., in which the asserted "1st spike" curls to extend essentially parallel, and not perpendicular to the hand grip portion of the knife, and the asserted "3rd spike" also extends essentially parallel, not perpendicular to the blade portion of the knife. Therefore, Applicant respectfully submits that Rae et al. does not teach or suggest every element of the presently pending subject matter.

Applicant further notes that with respect to the above discussed features lacking in Rae et al., one of ordinary skill in the art would understand that the **design** as disclosed by Rae, would utterly fail to resolve the problems which the presently claimed subject matter addresses and solves. For example, one of the reasons the handheld weapon of the presently claimed subject matter is configured as recited in the present claims, is that such

a configuration allows the use of at least the first and third spikes as directional spikes. See Applicant's Fig. 5A.

In view of the foregoing, Applicant respectfully submits that Rae et al. does not teach each and every element of the claims as required for anticipation under 35 U.S.C. § 102. Applicant further respectfully submits that one of ordinary skill in the art would not have learned the construction of the handheld weapon of the present application from the disclosure of Rae et al.

Accordingly, Applicant respectfully submits that claims 3-12 are also not anticipated by Rae et al., *inter alia*, at least due to their direct or indirect dependency from patentable claim 1.

Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 1 and 3-12.

II. At page 4 of the Official Action, claims 2 and 15-36 have been rejected under 35 USC § 103(a) as being unpatentable over Rae [et al.] in view of matters considered old and well known to striking weapons as set forth in the previous office action

The Examiner has made the following rejections: (i) claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "finger ridges to improve grip on hand held devices are old and well known. To have placed finger ridges on Rae would have been obvious in order to improve ones grip on the device"; (ii) claims 15 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well

known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "it is old to provide fur material to devices in order to make them more comfortable, it would have been obvious to have applied a fur like material to Rae in order to make it more comfortable to grip"; (iii) claims 16-23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "combining diverse articles such as key rings, tools, stun circuits, gas ejecting means and audible noise generation is old to striking weapons. To have combined such with Rae would have been obvious in order to combine the known utility of those articles into the device of Rae"; (iv) claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "the selection of known materials in order to take advantage of known properties is considered obvious"; (v) claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "the use of wrist straps on weapons is considered old. To have provided one on Rae would have been obvious in order to prevent the device from becoming lost while in use"; (vi) claims 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "telescopic batons are old and well known. Combining such with

Rae would have been obvious in order to extend its striking distance"; (vii) claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "the use of sheaths and carrying cases are old and well known. To have provided one for Rae would have been obvious in order to make it easier and safer to carry"; (viii) claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "Rae is capable as being used to carry bags"; (ix) claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "Fitting weapons such as brass knuckles with a belt clip is old. To have provided Rae with a belt clip as called for by claim 33 would have been obvious in order to attempt to disguise it as a belt buckle"; and (x) claims 34-36 under 35 U.S.C. § 103(a) as being unpatentable over Rae et al. "in view of matters considered old and well known to striking weapons as set forth in the previous office action, "asserting and repeating from the previous Official Action "it has been held that the addition of instructions for how to use a device cannot impart patentability. See *In re Ngai* (5-13-04)(Michel, Garjarsa, Linn)(per curiam)."

In view of the following, these rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, the Examiner must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co.*

v. *Teleflex Inc. et al.*, 550 U.S. 398 (2007), “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” (*KSR, supra*, slip opinion at 13-15.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

It is submitted that a *prima facie* case of obviousness has not been established because nothing in any of the applied references, whether taken alone or in combination, teach or suggest all of the limitations of the claims as required by *In re Wilson*.

As discussed, amended claim 1 is directed to a handheld defense weapon, comprising:

a first hand grip portion extending along a first direction and comprising a first spike fitted at a first end of the first hand grip portion, and a second spike provided at a second end of the first hand grip portion, the first and second spikes facing in the same direction; and

a third spike at the first end of the first hand grip portion, extending in an opposite direction from the first spike, wherein the first and third spikes form a **second hand grip portion** extending **only** along a second direction generally **perpendicular** to the first direction" (emphases added).

As discussed above, claim 1 is non-obvious, novel and patentable over the cited references. Therefore, Applicant respectfully submits that with regard to (i) – (ix), claims 2 and 15-33 are novel and non-obvious over the cited Rae et al. reference, *inter alia*, at least due to their direct or indirect dependency from patentable claim 1, for the reasons discussed in detail above with reference to claim 1, which discussions are incorporated herein in their entirety.

Applicant respectfully submits that with regard to (x), claim 34 presents a kit system reciting features similar to those recited in claim 1, discussed above, and should be deemed non-obvious and patentable over the cited Rae et al. reference, *inter alia*, for the reasons discussed in detail above with reference to claim 1.

Similarly, Applicant respectfully submits that claims 35 and 36 are novel and non-obvious over the cited Rae et al. reference, *inter alia*, at least due to their direct dependency from patentable claim 34, for the reasons discussed in detail above with

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reference to claim 1.

In view of the foregoing, Applicant respectfully submits that nothing in the cited art reference (Rae et al.) renders the presently claimed subject matter obvious within the meaning of 35 U.S.C. §103(a). Therefore, Applicant respectfully submits that claims 2 and 15-36 are therefore non-obvious, novel and patentable over the cited reference. Accordingly, the Examiner is respectfully requested to withdraw these rejections.

CONCLUSION

Applicant asserts that the claims are in condition for immediate allowance and early notice to that effect is earnestly solicited. Should the Examiner deem that any further action by Applicant's undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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